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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/825,492 03/28/97 HUGHES

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EXAMINER

HSU, A

ART UNIT

PAPER NUMBER

2738

DATE MAILED:

07/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/825,492

Applicant(s)
HUGHES ET AL

Examiner
Alpus H. Hsu

Group Art Unit
2738



☒ Responsive to communication(s) filed on May 7, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3, 5-8, 14-16, 18-22, and 24-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 5-8, 14-16, 18-22, and 24-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on May 7, 1999 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 21, 22 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21, 22 and 26 are directed to a data format which does not belong to any statutory subject matter as indicated above.

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure.

The disclosure does not provide enough structural detail to enable an artisan to make and use the invention without undue experimentation.

The Court of Customs and Patent Appeals has held that, a disclosure which gives only a block diagram and a broad description of the functions of those blocks without disclosing the specific structure of the blocks or explaining the interconnection, timing and control of the various components is prima facie not enabling. In re Gunn, 190 U.S.P.Q. 402 (CCPA 1976). A conclusion of nonenablement is rebuttable, but the burden is upon applicant to come forward with evidence of enablement with regards to the specific invention claimed. *Id.* at 405.

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The drawings in this case are a series of block diagrams. The detailed description does not specify any structure for the various blocks or explain how the components connect to each other and interact with each other to perform the functions claimed.

The specification answers none of these questions. Absent answers or evidence showing that an artisan would have known the answers without resort to undue experimentation, the disclosure is prima facie non-enabling under the rationale set forth in Gunn supra.

To comply with the enablement clause of the first paragraph of 35 U.S.C. § 112, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. In re Scarbrough, 500 F.2d 560, 182 U.S.P.Q. 298 (CCPA 1974); In re Brandstadter, 484 F.2d 1395, 179 U.S.P.Q. 286 (CCPA 1973); In re Gay, 309 F.2d 769, 135 U.S.P.Q. 311 (CCPA 1962). If the Examiner has a reasonable basis for questioning the sufficiency of the disclosure, the burden of proof shifts to applicant to come forward with evidence to rebut this challenge. In re Doyle, 482 F.2d 1385, 179 U.S.P.Q. 227 (CCPA 1973); In re Brown, 477 F.2d 946, 177 U.S.P.Q. 691 (CCPA 1973); In re Ghiron, 442 F.2d 985, 169 U.S.P.Q. 723 (CCPA 1971).

Applying this case law to the facts of this case, as discussed above the examiner believes that he has made out a reasonable prima facie case that the instant disclosure is not enabling. Thus the burden is on applicant to come forward with evidence showing enablement.

5. Claims 1-3, 5-8, 14-16, 18-20, 24 and 25 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification.

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6. Claims 1-3, 5-8, 14-16, 18-22, 24-26 are further rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly introduced feature of cell having a header that includes **information indicative of the merging method used** as in claims 1, 14 and 21 is not disclosed in any part of the specification.

7. Claims 1, 14 and 21 recite the limitation of "the merging method used" in each claim.

There is insufficient antecedent basis for this limitation in the claim.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1-3, 5-8, 14-16, 18-20, 24 and 25 are rejected under 35 U.S.C. 102(a) as being anticipated by Takashima et al. (of record).

By broadly interpreting the ATM cells (cells #1, #2, ... etc.) as the claimed partially filled ATM cells, and the new ATM cell (10) as the claimed merged ATM cell, Takashima et al. discloses a method and apparatus for merging partially filled ATM cells in ATM communications network (col. 10, lines 10-53, col. 14, line 30 to col. 15, line 26, and Figs. 28-31) as in claims 1-3, 5-8, 14-16, 18-20.

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10. The 102 (a) rejection has been repeated in view of the deficiency regarding 112, 1st and 2nd paragraph for the newly claimed limitation as indicated on paragraphs 6 and 7.

11. Applicant's arguments filed May 7, 1999 have been fully considered but they are not persuasive.

In the remark, regarding 101 rejection, the applicant argues that the patent office policy is flawed and the contents of the claimed data structure are real, tangible things and should qualify as patentable subject matter. The examiner disagrees on basis of 35 U.S.C. 101 statute.

Regarding 112, 1st paragraph, in response to applicant's argument that all devices and components are either conventional or well known and one of ordinary skill in the art would recognized the inventive process upon review of the disclosure, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding 102 rejection, the applicant merely argues that Takashima reference fails to teach or suggest newly introduced limitation of "cell including information indicative of the merging method used". However, the applicant fails to provide the support of the new claim limitation from the disclosure.

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In view of all of the above reasoning, the rejections regarding 101, 112 1st paragraph and 102(a) have been sustained.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

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(703) 305-3988 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

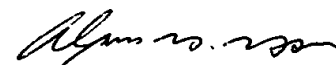
14. Any inquiry concerning this communication or earlier communications from the examiner
should be directed to Alpus H. Hsu whose telephone number is (703) 305-4377. The examiner
can normally be reached on Monday through Friday from 6:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,
Hassan Kizou, can be reached on (703) 305-4744.

Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Alpus H. Hsu *AHH*

July 14, 1999



**ALPUS H. HSU
PRIMARY EXAMINER**